

## REMARKS

### Prior Art

The primary aspect of the invention is its design in order to hold both bags and straps by the bag handle being over the strap.

This essential technology of the present invention is not shown in any of the prior art.

The fact that the prior art shows holders and bag holders but no device which holds a plurality of bags over a removable strap capable of sealing the bags shows the absence of obviousness.

Graham v. John Deere Co., 383 U.S. 1, 13-14, (1966)). These "underlying factual inquiries includ[e]: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness." In re Dembiczak, 175 F.3d 994, 998 (Fed. Cir. 1999). Similarly, "[t]he presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact," In re Gartside, 203 F.3d 1305, 1316 (Fed. Cir. 2000); accord Winner Int'l Royalty Corp. v. Wang, 202 F.3d 1340, 1348 (Fed. Cir. 2000).<sup>1</sup>

The Court of Appeals for the Federal Circuit's and its predecessor's "motivation to combine" requirement likewise prevents statutorily proscribed hindsight reasoning when determining the obviousness of an invention. Kahn, 441 F.3d at 986 ("[T]he 'motivation-suggesting-teaching' requirement protects against the entry of hindsight into the obviousness analysis."); In re Fridolph, 30 CCPA 939, 942 (1943) ("[I]n considering more than one reference, the question always is: does such art suggest doing the thing the [inventor] did."). According to the "motivation-suggesting-teaching" test, a court must ask "whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims." Kahn, 441 F.3d at 988 (citing Cross Med. Prods., Inc., v. Medtronic Sofamor Danek, Inc., 424 F.3d 1293, 1321-24 (Fed. Cir. 2005)).

1. This requirement has been developed consistent with the Supreme Court's obviousness jurisprudence as expressed in Graham and the text of the obviousness statute that directs us to conduct the obviousness inquiry "at the time the invention was made" 35 U.S.C. § 103. As we explained in Kahn,

The motivation-suggestion-teaching test picks up where the analogous art test leaves off and

The most similar prior art in this case is the 1,904,725 patent, which shows an arm type member 11, having on one end thereof a clip comprised of spring members 9 and 10.

This is designed to hold a plate on the arm resiliently so that the plate is supported on one end by arm 7 and on the other end by clip 9.

The difference between this invention and the present invention are several. But utilizing the broadest claim, there is no mechanism for supporting a strap both at the clip end by items 9 and 10 and on the opposite end of the arm 11 which is not designated but which is the end where the bags would be added if a strap were held in place and it was envisioned to use this for holding bags over the strap as shown in the present invention.

Perhaps the most striking difference lies in the failure to provide a strap means juxtaposed with the bag loader and dispenser of the type shown in the prior art (New Figure 20) and shown in conjunction with Figures 18 and 19.

Yet another difference between the embodiment shown in Figures 18 and 19 is having a means for dispensing more than one strap, the same being shown as item 61 and 62. There is also no holder in the prior art for dispensing a plurality of straps.

Yet another change from the prior art, is the failure to provide a means for holding a strap capable of looping in on itself between the rack arm front end and the rack room rear end.

While the 368 patent shows a arm, it is otherwise irrelevant to the present invention.

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informs the Graham analysis. To reach a non- hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as a whole to have been obvious in view of multiple references, the Board must provide some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct. The requirement of such an explanation is consistent with governing obviousness law .No. 06-1019 (Fed. Cir. 2006); Alza Corp. v. Mylan Laboratories Inc.;

Likewise, the 5,678,842 patent did not provide any mechanism for securing at either end, the strap means nor do they disclose the adjusted position of a loading means for the bags shown in Figures 18 and 19. Any device which separates the bags along the arm teaches away from this device which is designed to hold several bags on a single strap over a supporting arm and to allow the strap to release so it can loop together or be connected together as shown to remove the bags from the arm and hold them together.

The patent 4,830,385 similarly distinguishable and has none of the mechanisms for holding the strap at either end and nor does any of the prior art show a mechanism for dispensing multiple straps from a central location.

#### Claims

The word withdrawn has been deleted and replaced with "cancelled".

The claims have been amended to clarify the differences from the cited prior art.

The novelty includes a mechanism to hold a strap from either end so that bags may be loaded over the strap, to hold a plurality of handles so that they may be dispensed, sequentially or otherwise, over one or more arms, proximately locating a strap holder to a bag loader (a user location where a user may reach items to be bagged, bag the items, remove the loaded bag from a bag loader and place those over the strap over the arm for holding the strap and to thereafter lift the collected bags using the strap.

#### Specification

The Specification has been changed to point out where in the existing drawings the portions which were unclear are shown by renumbering those parts, mainly on Figure 18. Also, Figure 20 is added to show the portion of Figure 18 and 19 which was prior art and to distinguish

the fact that only that portion of Figures 18 and 19 was prior art and that Figures 18 and 19 show a new invention. Nothing is added to the drawings and no new matter is added.

#### CONCLUSION

For all of the reasons advanced above, Applicant respectfully submits that the application is in condition for allowance and that action is earnestly solicited.

No additional fee is believed necessary.

The commissioner is hereby authorized to charge any additional fees which may be required for this amendment, or credit any overpayment to Deposit Account 06-2129 in the name of Gregory M. Friedlander.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit account 06-2129.

Respectfully submitted,

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the fact that only that portion of Figures 18 and 19 was prior art and that Figures 18 and 19 show a new invention. Nothing is added to the drawings and no new matter is added.

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I hereby certify that this correspondence is being deposited with the United State Postal Service as Express Mail NO.: EV278560799 US in an envelope addressed to: Commissioner of Patents and Trademarks, Mail Stop Non-Fee Amendment, Alexandria, VA 22313 on the 1st day of May, 2007.

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